

## **REMARKS / ARGUMENTS**

In response to the Office Action mailed October 5, 2006, the Examiner's claim rejections have been considered. Applicants respectfully traverse all rejections regarding all pending claims and earnestly solicit allowance of these claims.

### **1. Claim Rejection – 35 U.S.C. § 102(e)**

The Examiner has rejected claims 153-155, 157-165, and 167-171 under 35 U.S.C. §102(e) as being anticipated by Walker (US 6,227,972). Applicants respectfully traverse this rejection. For the sake of brevity, the rejections of the independent claims 153 and 162 are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

Applicants respectfully submit that Walker does not anticipate the claimed invention because Walker does not disclose “a new promotional award that is not redeemable for game play.” The claimed new promotional award is configured to alter game play, enhance winning outcomes, trigger a bonus game, or a combination thereof. The new promotional award entices a player to play a game or to visit a gaming establishment without having to give the player any free play games. In sharp contrast, the Walker prepaid card is a debit or gift card that is a substitute for the player using cash to play a gaming machine. More specifically, Walker discloses an expiring prepaid card that may be (1) purchased by the player at face value; (2) given out by the casino to a player as a promotion or to preferred players; or (3) issued to a player as a payout on a slot machine.

The Examiner also argues that Walker teaches the step of “determining whether the new promotional award is applicable to at least one game on the gaming machine” in FIG. 7 (step 710). Applicants submit that step 710 of Walker discloses that the gaming machine determines whether the player has satisfied the requirements to access the balance of the expiring slot card. That is, Walker prevents a player from entering a slot card and then subsequently cashing out without playing any games. Applicants submit that requiring the player to play on the gaming machine before accessing the player card balance is very different from the claimed step of

determining whether the promotional award functions on a particular gaming machine. According to the claimed invention, the new promotional award may be configured to work on certain gaming machines. For example, if a player inserts the promotional award into an eligible gaming machine, the pay table of the game is reconfigured to provide greater payouts for winning outcomes. However, if the player inserts the claimed promotional award into an ineligible gaming machine, the pay table remains the same. This is very different than determining whether or not a player can access credits on a player card, as disclosed in Walker. The game in Walker remains the same whether or not the player inserts an expiring player card.

Furthermore, Applicants submit that Walker does not disclose that a game may be reconfigured in response to a promotional award. Rather, Walker merely discloses (in steps 720-755 of FIG. 7) that the credit balance may be changed if the player is given access to the balance on the player card. Applicants submit that changing the balance on the gaming machine is not the same as reconfiguring a game. In Walker, the balance may change, but the underlying game is played and operates in the same manner. In sharp contrast, the game of the claimed invention may be altered by enhancing winning outcomes, triggering a bonus game, or altering game play.

In conclusion, Applicants respectfully submit that the 35 U.S.C. §102(e) rejection of claims 153-155, 157-165, and 167-171 has been overcome.

## **2. Claim Rejections – 35 U.S.C. § 103(a)**

The Examiner has rejected claims 156 and 166 under 35 U.S.C. §103(a) as being unpatentable over Walker (US 6,227,972) in view of Walker (US 6,364,765).

Applicants note that claims 156 and 166 are dependent claims that depend from independent claims 153 and 162, respectively. In light of the arguments submitted in Section 1 of this response, Applicants respectfully submit that dependent claims 156 and 166 are not obvious in view of the combination of Walker '972 and Walker '765 because these references, alone or in combination, fail to teach or suggest all the claimed limitations. Moreover, these dependent claims further recite and define the claimed invention, and thus, are independently patentable. In conclusion, Applicants respectfully submit that the 35 U.S.C. §103(a) rejection of claims 156 and 166 has been overcome.

**CONCLUSION**

Applicants have made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 153-171 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name STEPTOE & JOHNSON LLP.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 734-3200. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,

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